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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,648	03/07/2001	Stacey J. Swart	10004942-1	3330
7590	11/07/2005		EXAMINER	
HEWLETT-PACKARD COMPANY			HUTTON JR, WILLIAM D	
Intellectual Property Administration			ART UNIT	PAPER NUMBER
P.O. Box 272400				2176
Fort Collins, CO 80527-2400			DATE MAILED: 11/07/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/800,648	SWART ET AL.	
	Examiner	Art Unit	
	Doug Hutton	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,8,10-14,17,19-21 and 23 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,8,10-14,17,19-21 and 23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 March 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Applicant's Response

In Applicant's Response dated 6 October 2005, Applicant amended Claims 1, 10, 20, 21 and 23, cancelled Claims 9, 18, 22 and 24, and argued against all objections and rejections previously set forth in the Office Action dated 8 July 2005.

The objection to the Specification previously set forth is withdrawn.

Specification

The disclosure is objected to because of the following informalities:

- on Page 3, the term "file" should be inserted between the terms "(SGML)" and "and" in Line 14 because the "*technical writing tool*" generates a SGML file (see Page 3, Lines 23-25); and
- on Page 3, the term "an" in Line 14 should be amended to — the — because the "*conversion tool*" takes an SGML file that was generated by the "*technical writing tool*" and converts it into an HTML file (Page 3, Lines 23-26).

Appropriate correction is required.

Claim Objections

Claims 1, 10, 20, 21 and 23 are objected to because of the following informalities:

- in Claim 1, Line 14 → the term “said” should be inserted between the terms “*mapping*” and “*styles*” because the “*styles defined by [the] style templates*” were previously mentioned (see Line 10);
- in Claim 1, Line 15 → the phrase “that are” should be inserted between the terms “*styles*” and “*to*” so the limitation reads more clearly; and
- in Claim 1, Lines 15-17 → the limitation “*said second logic further configured to define styles of elements in said second markup language file based on said styles mapped to said style templates by said mappings*” should be deleted because:
 - 1) The phrase “*said styles mapped to said style templates by said mappings*” (see Lines 16-17) is inaccurate since the “*mappings*” (see Line 14) pair together the “*defined **styles** of the external style templates*” (i.e., the “*styles*” of the elements comprising the SGML file) and the “*styles [that are] to be used in the second markup language file*” (i.e., the “*styles*” of the elements comprising the HTML file). There are many “*styles*” mentioned in Claim 1, several of which are **repetitive** and **unnecessary**.
The only true “*styles*” in Claim 1 are:
 - a) the “*styles*” of the first markup language file (i.e., the “*styles*” of the elements comprising the SGML file), which are defined by the “*style templates*” (see Line 5 and Lines 9-10); and
 - b) the “*styles*” of the second markup language file (i.e., the “*styles*” of the elements comprising the HTML file), which are obtained from

the mappings that match up the SGML "styles" with the corresponding HTML "styles." To summarize – "first markup language" styles are initially established, and then the "first markup language" styles are mapped to "second markup language" styles which are to be used when converting the first markup language file to the second markup language file. In other words, during the conversion of the SGML document into the HTML document, the style of any particular SGML element being converted is looked up in the mappings to determine which HTML style to used in the conversion.

- 2) This limitation is repetitive because the "*styles of elements in said second markup language file*" (see Line 16) are exactly the same as the "*styles [that are] to be used in said second markup language file*" (see Line 15). If the examiner is incorrect, then Applicant should explain how the scopes of these phrases differ in the reply to this Office Action.
- Claims 10, 20, 21 and 23 have the same problems listed above.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 8, 10-14, 17, 19 and 21 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 8 and 21:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 1 recites “[a]n apparatus . . . comprising:” a “first logic” and a “second logic” (see Claim 1, Lines 1, 2 and 9). Although the preamble identifies the invention as an “apparatus,” the recited elements of the invention clearly indicate that it is a **computer program**. Because the claim fails to recite that the software is embodied on a tangible computer-readable medium, the invention is neither concrete nor tangible, as currently recited.

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. MPEP § 2106.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Thus, as currently recited in Claim 1, the invention is **functional descriptive material** because it comprises merely a method of manipulating data.

Claim 21 has the same problems mentioned in the above discussion for Claim 1.

Claims 2-5 and 8 are also rejected because these claims are dependent upon Claim 1 and recite no limitations that make the invention concrete and tangible.

Applicant may obviate these rejections by amending the preambles of Claims 1 and 21 to read: — A computer program tangibly embodied on a computer-readable medium, comprising: —.

Claims 10-14, 17 and 19:

The subject matter specified in the claims is non-statutory and fails to recite patent-eligible subject matter in that it is not in the useful or technological arts. Additionally, the claimed invention is so abstract and sweeping that it covers the method as practiced by a human operator assisted only by pencil and paper. The claims do not include a particular machine or apparatus, and no machine-implemented steps are

recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process," is not patentable subject matter.

"Phenomena of nature, though just discovered, *mental processes*, abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (emphasis added) *Gottschalk v. Benson*, 75 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing* U.S.P.Q. 571 (1969).

Claims 11-14, 17 and 19 are also rejected because these claims are dependent upon Claim 10 and recite no limitations that cure the problems mentioned in the above discussion.

Applicant may obviate this rejection by amending the preamble of Claim 10 to read: — A computerized method for generating files, the method comprising: —.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 10-14, 17, 19-21 and 23 remain rejected under 35 U.S.C. 102(b) as being anticipated by <http://web.archive.org/web/19991111161335/http://>

www.scriptorium.com/index.html (hereinafter, Scriptorium), as it appeared on 1 March 2000.

Claim 1:

Scriptorium discloses *an apparatus for generating files* (see Pages 1-14 of 14 – Scriptorium discloses this limitation, as clearly indicated in the cited text), *the apparatus comprising*:

- *a first logic configured to perform a technical writing tool algorithm* (see Page 2 of 14 – Scriptorium discloses this limitation in that it teaches FrameMaker and FrameMaker+SGML), *the technical writing tool algorithm for receiving input describing a particular selected format and content for a document* (see Page 2 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML allow the user to specify a structure for a document and flow content into the document structure), *the technical writing tool algorithm for processing said input to generate a first markup language file of a first markup language* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML creates SGML documents) *based on an elements file* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML, when creating an SGML document, refer to the document structure specified by the user. The “structure” specified by the user is defined in an Element Definition Document.) *and a plurality of style templates external to said elements file* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML, during the

creation of an SGML document, use FrameMaker formatting to style the SGML elements. Scriptorium mentions FrameMaker templates and FrameMaker formatting repeatedly. These templates and formatting comprise the “*styles*” for paragraphs, characters, headings, lists, tables, etc. included in the SGML document that is created. In other words, the elements in an Element Definition Document have “*styles*” associated with them through the FrameMaker templates and FrameMaker formatting. Because the FrameMaker templates and FrameMaker formatting are not part of the Element Definition Document, the “*styles*” are “*external*.” Also, because a user may map FrameMaker tags to HTML tags using WebWorks Publisher, the FrameMaker tags are “*external*” to the Element Definition Document.), *said elements file defining elements included in said first markup language file and a structure for each of said elements* (Scriptorium discloses this limitation in that the Element Definition Document comprises elements and the structure for each element), *wherein said first markup language file is printable as a hardcopy document* (Scriptorium discloses this limitation in that FrameMaker is used to print hardcopy documents), *said first markup language file including first markup language formatting information* (Scriptorium discloses this limitation in that FrameMaker and FrameMaker+SGML outputs documents in SGML format), *said first logic configured to define styles of said elements in said first markup language file based on said plurality of style templates* (This limitation simply repeats the limitation “*generate a first markup language file . . . based on . . . style templates*”

previously recited in Lines 4-5. As indicated in the above discussion, Scriptorium discloses this limitation.), *each of said style templates defining a style for a respective one of said elements* (As indicated in the above discussion, FrameMaker templates and FrameMaker formatting comprise the "styles" for paragraphs, characters, headings, lists, tables, etc. Thus, each element in an Element Definition Document has an associated "style."); and

- *a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file of a second markup language* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that it teaches WebWorks Publisher, which is a conversion tool that is used to convert FrameMaker files to HTML. That is, WebWorks Publisher may be used to convert SGML documents to HTML documents.) *based on a plurality of mappings for mapping styles defined by said style templates to styles to be used in said second markup language file* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that it teaches WebWorks Publisher, which is a mapping tool that offers control over the mappings of FrameMaker tags to HTML tags), *said second logic further configured to define styles of elements in said second markup language file based on said styles mapped to said style templates by said mappings* (see Pages 2-14 of 14 – Scriptorium discloses this limitation in that the HTML tags in the mappings define the style of the elements in the HTML document), *wherein said second markup language file includes a second markup language formatting*

information describing a particular on-line format and content of said document
(see Page 2 of 14 – Scriptorium discloses this limitation in that it teaches HTML documents for publishing online content).

Claim 2:

Scriptorium discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the first markup language file is printed (Scriptorium discloses this limitation in that FrameMaker allows the user to specify the document structure in the Element Definition Document. The Element Definition Document may be used to output a document in SGML format.).

Claim 3:

Scriptorium discloses the apparatus of Claim 1, wherein said input describing said particular format includes style information that describes a style that document elements are to have if the second markup language file is placed on-line (Scriptorium discloses this limitation in that WebWorks Publisher converts the FrameMaker document into an HTML document that has “style information” that instructs a computer how to present the HTML document online).

Claim 4:

Scriptorium discloses *the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language* (as specified in the above rejection for Claim 1, the first markup language is SGML).

Claim 5:

Scriptorium discloses *the apparatus of Claim 1, wherein said second markup language is a Hypertext Markup Language* (as specified in the above rejection for Claim 1, the second markup language is HTML).

Claim 8:

Scriptorium discloses *the apparatus of Claim 1, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language* (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

Claims 10-14 and 17:

Claims 10-14 and 17 merely recite the method performed by the apparatus of Claims 1-5 and 8, respectively. Thus, Scriptorium discloses every limitation of Claims 10-14 and 17, as indicated in the above rejections for Claims 1-5 and 8.

Claim 19:

Scriptorium discloses *the method of Claim 18, wherein said first markup language is a Standard Generalized Markup Language and wherein said second markup language is a Hypertext Markup Language* (as specified in the above rejection for Claim 1, the first markup language is SGML and the second markup language is HTML).

Claim 20:

Claim 20 merely recites computer software that performs the same method performed by the apparatus of Claim 1. Thus, Scriptorium discloses every limitation of Claim 20, as indicated in the above rejection for Claim 1.

Claim 21:

Claim 21 merely recites limitations included in Claim 1. Thus, Scriptorium discloses every limitation of Claim 21, as indicated in the above rejection for Claim 1.

Claim 23:

Claim 23 merely recites the method performed by the apparatus of Claims 1-5 and 8. Thus, Scriptorium discloses every limitation of Claim 23, as indicated in the above rejections for Claims 1-5 and 8.

Response to Arguments

Applicant's arguments filed 6 October 2005 have been fully considered but they are not persuasive.

Arguments against the 101 rejections:

Applicant argues that the subject matter recited in Claim 1 is statutory subject matter because it is well known that logic may be implemented in software or hardware. See Response – Page 12, second paragraph through fourth paragraph.

The examiner disagrees.

Claim 1 recites a “*first logic*” (see Line 2) and a “*second logic*” (see Line 12). The claim language, when considered as a whole, clearly indicates that the invention of Claim 1 is a computer program (i.e., an algorithm). The claim does not recite that the computer program is tangibly-embodied on a tangible computer-readable medium. Thus, the invention recited in Claim 1 is the algorithm itself. The algorithm alone, without the use of a computer, cannot produce a useful, concrete and tangible result. Accordingly, the subject matter recited in Claim 1 is nonstatutory.

The examiner fails to see how Applicant's argument – that it is well known that logic may be implemented in software or hardware – is relevant to the question of whether Claim 1 recites statutory subject matter.

Applicant argues that many issued patents have claims reciting "logic configured to" without reciting that such "logic" is embodied on a computer-readable medium. See *Response* – Page 12, fifth paragraph through Page 13, first partial paragraph.

The examiner will not comment on the claim language recited in issued patents because it is the Office's policy not to comment on the validity of registered patents.

Arguments against the 102 rejections:

Applicant's arguments with respect to the 102 rejections have been considered but are moot in view of the new rationale discussed in the above rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
November 3, 2005



DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100